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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,327	11/13/2003	Daniel Craven	P-US-PR-1091	1986
7590	08/15/2005		EXAMINER	
Michael P. Leary Group Patent Counsel Black & Decker Corporation, Mail Stop TW199 701 E. Joppa Rd Towson, MD 21286			DURAND, PAUL R	
			ART UNIT	PAPER NUMBER
			3721	
DATE MAILED: 08/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/712,327	CRAVEN ET AL.
	Examiner	Art Unit
	Paul Durand	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 June 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 June 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Drawings***

1. The drawings were received on 6/13/2005. These drawings are accepted.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,3,5 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bausch (US 4,588,910).

In regard to claim 1, Bausch discloses the invention as claimed including a hand held tool with electric motor "M", integrated switch unit, with motor control unit, which turns the motor on and off (indicated by on/off housing 35), manual switch member in the form of trigger 2, operatively connected to the motor control unit; second manually operated switch member in the form of second housing 36, located remotely (not integral with the switch unit) in a position that allows the user to see the switch during normal operation by it's location on the handle, linkage assembly in the form of crank 25, which operatively connects the second switch to the motor control unit through an actuator in the form of pin 40, which is moved in response to the movement of the

second switch member to move the motor in a forward or reverse direction (see Fig. 1-3,6 and C3,L4 – C4,L59).

In the alternative, if it is argued that the reference of Bausch does not show the second switch remote from the switch unit, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have remotely located the second switch from the motor control unit, since it has been held that constructing a formerly integral structure in various elements involves only routing skill in the art.

*Nerwin v. Erlichman*, 168 USPQ 177, 179.

In regard to claims 2 and 3, Bausch discloses the invention as claimed including forward and reverse member 9, located on a portion of the tool which can be seen by the user and on an upwardly portion of the tool (see Fig. 1-3 and 6).

In regard to claim 5, Bausch discloses the invention as claimed including linkage 25 pivotally mounted at 40 (see Figs. 3 and 6).

In regard to claim 15, Bausch discloses the invention as claimed including power member in the form of trigger switch 2 (see Fig.2).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-8,13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch.

In regard to claims 6 and 7, Bausch discloses the invention substantially as claimed except for the location of the linkage. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have located the linkage on the motor housing next to the motor, since it has been held that rearranging parts of an invention involves only routing skill in the art. *In re Japiske*, 86 USPQ 70.

In regard to claim 8, Bausch discloses the invention as claimed including a closed end of the motor housing located at the rear end (see fig.2).

In regard to claims 13 and 14, Bausch discloses the invention substantially as claimed except for the linkage being comprised of plural arms instead of a single arm. However, the examiner takes Official Notice that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the linkage with two arms, or essentially a hollow portion in the middle of a single structure for the purpose of preventing interference of parts during assembly.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch in view of Becker et al (US 6,199,642).

Bausch discloses the invention substantially as claimed except for the reverse member being located on an upward face if the tool. However, Becker teaches that it is old and well known in the art to provide a reverse switch in the form of reversing cap 22 which is located on an upper face of the tool and power member in the form of trigger

14, which is located on a downward portion of the tool for the purpose of efficiently operating a tool (see Fig.1 and C2,L38-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the switch and trigger arrangement as taught by Becker for the purpose of efficiently operating a tool.

7. Claims 9,10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch in view of Dibbern et al (US 4,684,774).

Bausch discloses the invention substantially as claimed except for the pivoting member mounted on a boss at the rear of a tool. However, Dibbern teaches that it is old and well known in the art to provide an adjusting member 62, which rotates longitudinally to a tool motor, mounted on a bearing boss 21 and fixing boss 23 which attaches rear cover and limits the movement of the adjusting member 62 for the purpose of operating and reducing the size of a tool (see Figs. 2,11,13 and C5,L21-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the switch arrangement as taught by Dibbern for the purpose of operating and reducing the size of a tool.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch in view of Schell et al (US 5,738,177).

Bausch discloses the invention substantially as claimed except for the housing being formed as a jam pot housing. However, Schell teaches that it is old and well known in the art to provide a housing formed from a jam pot design for the purpose of

increasing the ease of manufacture (see Fig.1 and C5,L29-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the housing as taught by Schell for the purpose of increasing the ease of manufacture.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch in view of Grossmann et al (US 4,342,931).

Bausch discloses the invention substantially as claimed except for the safety mechanism, which prevents the reverse member from moving while the tool is in operation. However, Grossmann teaches that it is old and well known in the art to provide an power switch arrangement, which prevents the slide 28 from moving during operation for the purpose of preventing damage to a tool (see Figs and C8,L62 – C9,L13). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the safety device as taught by Grossmann for the purpose of preventing damage to a tool.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch in view of Dibbern.

Bausch discloses the invention as claimed including a hand held tool with housing, upper and lower facing portions, downward extending handle, electric motor "M", integrated switch unit, with motor control unit, which turns the motor on and off (indicated by on/off housing 35) and located in the handle area, first manual switch member in the form of trigger 2, operatively connected to the motor control unit and projecting through the handle, second manually operated switch member in the form of

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second housing 36, located remotely (not integral with the switch unit) in a position that allows the user to see the switch during normal operation by it's projected location on the handle, linkage assembly in the form of crank 25, which operatively connects the second switch to the motor control unit through an actuator in the form of pin 40, which is moved in response to the movement of the second switch member to move the motor in a forward or reverse direction (see Fig. 1-3,6 and C3,L4 – C4,L59). What Bausch does not disclose is the position of the switch projecting from the top of the housing and the switch seated on a boss. However, Dibbern teaches that it is old and well known in the art to provide an adjusting member 62, with a switch member 79, projecting from the top of the tool, which rotates longitudinally to a tool motor, mounted on a bearing boss 21 and fixing boss 23 which attaches rear cover and limits the movement of the adjusting member 62 for the purpose of operating and reducing the size of a tool (see Figs. 2,11,13 and C5,L21-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the switch arrangement as taught by Dibbern for the purpose of operating and reducing the size of a tool.

#### ***Response to Arguments***

11. Applicant's arguments filed 6/13/2005 have been fully considered but they are not persuasive.

Applicant argues that the amendment of claim 1 to place the second switch member remote from the switch unit overcomes the prior art if Bausch. The examiner does not agree. First, given the broadest reasonable interpretation of remote, the examiner asserts that the second switch need only be outside the housing of the switch unit (i.e. not integral). This is further shown by Bausch linkage assembly 25, which connects the switch to the unit through actuating pin 40. Second, assuming arguendo that the second switch is not remote from the switching unit, the examiner asserts that the separation of formerly integral parts is well known in the art. See *Nerwin v. Erlichman*, 168 USPQ 177, 179.

If applicant intends to argue that there is not motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, regarding bodily incorporation, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Lastly, regarding claims 13 and 14, applicant has not seasonably traversed the examiner's position of Official Notice, and as such is deemed to be admitted prior art. See MPEP § 2144.03.

Therefore, for the reasons indicated above, the rejection is deemed proper.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

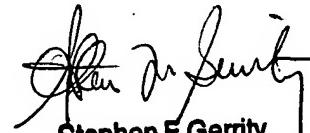
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
August 9, 2005

  
Stephen F. Gerrity  
Primary Examiner  
571-272-4460